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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/836,386	04/18/2001	Susumu Honma	109296	7176

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EXAMINER

EHICHIOYA, FRED I

ART UNIT	PAPER NUMBER
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2162

DATE MAILED: 01/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/836,386

Applicant(s)

HONMA ET AL.

Examiner

Fred I. Ehichioya

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-- The MAILING DATE of this communication appears on the cover sheet with the corresponding address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 - 12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 - 12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments, with respect to claims 1 – 12, filed September 3, 2004 have been fully considered but they are not persuasive for the following reasons.

2. Applicants argue that Shimotsuji and Smith, alone or in combination, do not teach or suggest a data as recited in claim 1, and similarly recited in claim 5 for data input form retrieving method, and in claim 9 for a computer-readable recording medium, page 5, paragraph 1. Examiner respectfully disagrees with the applicants. Examiner in the last Office Action responded to these allegations in claims 1, 5 and 9 by citing the lines and columns of the references on record.

Applicants also states that there is no motivation to combine features related to data line extraction of Shimotsuji with data entry teaching of Smith, nor has the Office Action established sufficient motivation for a *prima facie* case of obviousness Page 3, paragraph 2.

Again Examiner respectfully disagrees with the applicants. "Test of obviousness is not whether features of secondary reference may be bodily incorporated into primary reference's structure, nor whether claimed invention is expressly suggested in any one or all of references; rather, test is what combined teachings of references would have suggested to those of ordinary skill in art." In re Keller, Terry, and Davies, 208 USPQ 871 (CCPA 1981). The combination of Shimotsuji and Smith clearly suggest the applicants' invention in claims 1, 5 and 9. "The reason or motivation to modify the

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reference may often suggest what the inventor has done, but for a different purpose or to solve a different problem. It is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by the applicant. *In re Linter*, 458 F.2d 1013, 173 USPQ 560. The motivation to combine Smith and Shimotsuji is that there is a preservation of data even if the system crashes.

3. In view of the above, the examiner contends that all limitations as recited in the claims have been addressed in this Action. For the above reasons, Examiner believed that rejection of the last Office action was proper.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1 - 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,815,704 issued to Shigeyoshi Shimotsuji et al (hereafter "Shimotsuji") in view of U.S. Patent 5,963,952 issued to Derek Kent William Smith (hereinafter "Smith").

Regarding claim 1, Shimotsuji teaches a data input form retrieving system comprising:

character string extracting means for extracting a character string out of each of plural data input forms containing character strings ("character-line extraction means for extracting line data and character data from the input image data", see column 1, lines 55 – 57);

extracting conditions input means for inputting a condition of extracting a specific data input form out of the plural data input forms ("image input means for inputting image data of a new document; extraction means for extracting line data from the new document input image data", see column 2, line 15 - 17);

and data input form extracting means for extracting the specific data input form by retrieving the character string extracted by the character string extracting means in accordance with the extracting condition inputted by the extracting condition input means ("image input means for inputting image data of a new document; character-line extraction means for extracting line data and character data from the input image data" see column 2, lines 2 - 5).

Shimotsuji does not explicitly disclose wherein a text file containing the character strings extracted from the data input form is made up when the character strings have been extracted from each of the plural data input forms.

However, Smith discloses wherein a text file containing the character strings extracted from the data input form is made up when the character strings have been extracted from each of the plural data input forms (see column 2, line 65 through column 3, line 5 and column 6, line 1 through column 13, line 11).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine teaching of Smith with the teaching of Shimotsuji wherein the set of form tags are input tags for txt fields. Data entered into the primary document is extracted and entered into the secondary document as initial values for the input tags. The motivation is that the data captured into the secondary document is stored to a local storage file for a later transmission to a Web server in this case data is still preserved even if there is circuit interruption.

Regarding claims 2, 6 and 10, Smith teaches all the character strings contained in each of the plural data input forms are extracted (see column 6, lines 3 - 8).

Regarding claims 3, 7 and 11, Smith teaches a specific character string is selected out of the character strings contained in the plural data input forms (see column 6, lines 54 - 60).

Regarding claims 4, 8 and 12, Shimotsuji teaches a data input form retrieving system comprising:

keyword adding means for adding a keyword to each of plural data input forms ("keyword is inputted to retrieve data desired by a user", see column 1, lines 35 – 36);

extracting condition input means for inputting a condition of extracting a specific data input form out of the plural data input forms ("image input means for inputting

image data of a new document; extraction means for extracting line data from the new document input image data”, see column 2, lines 15 – 17); and

data input form extracting means for extracting the specific data input form by retrieving the keyword added by the keyword adding means in accordance with the extracting condition inputted by the extracting condition input means (“image input means for inputting image data of a new document; character-line extraction means for extracting line data and character data from the input image data” see column 2, lines 2 – 5).

Shimotsuji does not explicitly disclose wherein a text file containing the keywords extracted from the data input form is made up when the keywords have been extracted from each of the plural data input forms.

However, Smith discloses wherein a text file containing the keywords extracted from the data input form is made up when the keywords have been extracted from each of the plural data input forms (see column 2, line 65 through column 3, line 5 and column 6, line 1 through column 13, line 11).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine teaching of Smith with the teaching of Shimotsuji wherein data extracted are words, keywords or sentences. Data entered into the primary document is extracted and entered into the secondary document as initial values for the input tags. The motivation is that the data captured into the secondary document is stored to a local storage file for a later transmission to a Web server in this case data is still preserved even if there is circuit interruption.

Regarding claims 5 and 9, Shimotsuji teaches a data input form retrieving method comprising:

- extracting a character string out of each of plural data input forms containing character strings (see column 1, lines 55 – 57 and column 3, lines 46 – 47; “The character line extraction section 2 extracts line/character from the input image data”);

- inputting a condition of extracting a specific data input form out of the plural data input forms (see column 6, lines 8 – 20 “inputting a condition of extracting is the inputting a blank form”).

- extracting the specific data input form by retrieving the extracted character string in accordance with the inputted extracting condition (see column 8, lines 24 – 29;).

Shimotsuji does not explicitly disclose wherein a text file containing the character strings extracted from the data input form is made up when the character strings have been extracted from each of the plural data input forms.

However, Smith discloses wherein a text file containing the character strings extracted from the data input form is made up when the character strings have been extracted from each of the plural data input forms (see column 2, line 65 through column 3, line 5 and column 6, line 1 through column 13, line 11).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine teaching of Smith with the teaching of Shimotsuji wherein the set of form tags are input tags for txt fields. Data entered into the primary document is extracted and entered into the secondary document as initial values for the input tags. The motivation is that the data captured into the secondary document is

stored to a local storage file for a later transmission to a Web server in this case data is still preserved even if there is circuit interruption.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fred I. Ehichioya whose telephone number is 571-272-4034. The examiner can normally be reached on M - F 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John E. Breene can be reached on 571-272-4107. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Fred I. Ehichioya
Patent Examiner
Art Unit 2162

January 12, 2005

Mohammed Ali
Primary Examiner
Art: 2162